

**REMARKS**

The Office Action mailed on February 17, 2004, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1, 3-6 and 9 were pending. By this paper, Applicant does not cancel or add any claims. Therefore, claims 1, 3-6 and 9 remain pending in the present application.

Applicant respectfully submits that the present application is in condition for allowance for the reasons that follow.

**Publication No. 2000-16704 is not a Valid Reference Under 35 U.S.C. §102(b)**

For a patent application publication to be used to reject a claim under 35 U.S.C. §102(b), that reference must have been published more than 1 year before the application date of the application containing the rejected claims.

Applicant is entitled to a filing date of July 12, 2000, the filing date of PCT/JP01/06039, which is the PCT application from which the present application claims priority. Since Publication No. 2000-167043 was published less than 1 year before July 12, 2000 (Publication No. 2000-167043 was published on June 20, 2000), it is not a 102(b) reference. Still, Applicant responds to the merits of the rejection, since, notwithstanding its publication date, it does not anticipate any of the pending claims.

**The Finality of the Office Action Is Improper**

Applicant's amendments **did not** necessitate a new ground for rejection. In the Response of November 25, 2003, Applicant merely moved the limitations of claim 2 into claim 1 (thus effectively placing claim 2 into independent form), and amended claim 9 to address certain informalities identified by Applicant's representative. Thus, Applicant's amendments did not necessitate the new grounds of rejection per MPEP §706.07(a), since claims 2 and 9 are in their original form.

Applicant respectfully submits that **the finality of the Office Action should be withdrawn**, and, if the claims are not allowed, another office action instead of an advisory action should be issued.

**The Office Action does not Identify Specific Elements of the Cited References**

Other than one instance in regard to claim 5, the Office Action does not specifically identify a **single element** of the device of Publication No. 2000-167043 that corresponds to the features of the present invention. In rejecting every claim other than claim 5, the Office Action simply states that “Japanese Publication 2000-167043 discloses” the invention, followed by a recitation of the claim language without any direction as to what features of Publication No. 2000-167043 correspond to the claim elements.<sup>1</sup>

Applicant respectfully submits that the Office Action is insufficient since it does not contain a specific reference to a single element of the Publication in regards to any of the independent claims. Applicant requests that if the claims are not allowed, any next paper from the PTO rejecting the claims specifically identify the elements of the prior art that correspond to the features of the claims.

**Rejections Under 35 U.S.C. § 102**

Claims 1, 3-6 and 9 stand rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Publication No. 2000-167043 (the Publication). In response, Applicants traverse the rejections as to the claims above, and respectfully submit that the above claims are allowable for at least the reasons that follow.

Applicants rely on MPEP § 2131, entitled “Anticipation – Application of 35 U.S.C. 102(a), (b), and (e),” which states that a “claim is anticipated only if each and every element

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<sup>1</sup> Moreover, the one time that the Office Action specifically cites a reference number relating to an element of Publication No. 2000-167043 (the reference number “58,” identified in the Office Action when rejecting claim 5), the cited reference number does not even appear in Publication No. 2000-16704.

as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” It is respectfully submitted that the Publication does not describe each and every element of claims 1, 3-6 and 9.

**Claim 1:** Claim 1 recites a socket for a dialyzer that connects to a plug, comprising, among other things, (a) an outer sleeve fitted onto a coupling part of the socket main body, (b) “a spring-biased holder for pressing a locking ball, the holder being accommodated between the socket main body and the outer sleeve,” and (c) “a front end portion of the holder constituting a protrusion that externally protrudes from a front end surface of the outer sleeve.” That is, for a prior art socket to anticipate claim 1, it must have a holder that presses a locking ball that is located between an outer sleeve and the main body of the socket, where the holder has a protrusion that externally protrudes from a front end surface of the outer sleeve.

The Publication does not have such a feature. Assuming *arguendo* that element 41 of Fig. 1 meets the requirement of an outer sleeve, no spring-biased holder for pressing the locking balls 43 is accommodated between any possible socket main body of the Publication and element 41, where “a front end portion of the holder [constitutes] a protrusion that externally protrudes from a front surface of the outer sleeve.”

Moreover, claim 1 recites that “the socket is capable of being attached to or removed from the plug with a single operation because of the locking ball being temporally released by the holder moving back and forth when the socket is to be attached to or removed from the plug.” In an exemplary embodiment of the invention according to claim 1, the holder 42 presses the locking ball 41 forward by the action of the spring force of the coil spring 43, and then the locking ball 41 is spring-biased in the direction indicated by the arrow in FIG. 1 along a tapered surface 324 (see FIG. 3) formed in the inner surface of the front side sleeve 32, thereby maintaining the locking state of the plug. Conversely, when the holder 42 is retracted against the pressure of the coil spring 43 by pulling the socket away from the plug, the locking ball 41 is released.

The Publication does not disclose such a feature, and the Office Action does not allege anything to the contrary. **Indeed, the Office Action completely ignores this feature when rejecting claim 1.** This is not surprising, since, based on Fig. 1 (the sole portion of the Publication relied on to reject claim 1), it appears that the socket of the Publication requires that element 41 must be retracted manually upon connecting the socket and the plug in order to release the locking ball, and thus the socket of the Publication does not anticipate claim 1.

Applicant reminds the PTO that functional recitations are acceptable in apparatus claims, and that such recitations should be given patentable weight as a structural limitation because the claim presents structural attributes of the present invention. In support of this assertion, Applicant relies on the second paragraph of MPEP § 2173.05(g), which states that a “functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art.” (See also the last paragraph of MPEP § 2173.05(g), citing *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976)).

In sum, claim 1 is not anticipated by the Publication. Therefore, the claims that depend from claim 1, claims 3, 4 and 5, likewise are not anticipated by the Publication.

**Claim 3:** Claim 3 recites further recitations relating to the protrusion on the front end portion of the holder and the front end surface of the outer sleeve. Specifically, claim 3 recites that these elements are “configured to be visually discriminable.”

First, as noted above, the Publication does not meet the requirements of claim related to the protrusion. Second, assuming *arguendo* that the recitations of claim 1 were met (which it does not), the Publication does not appear to teach that visual confirmation of a locking state of a socket and a plug is a feature of the devices shown in the figures of the Publication. Thus, claim 3 is allowable for this additional reason.

**Claim 4:** Claim 4 is allowable for at least the reason that it depends from claim 1.

**Claim 5:** Claim 5 recites that “the coupling part of the socket main body has, on an inner wall thereof, an end face seal that abuts against an end of the plug of the dialyzer.” In an exemplary embodiment, the invention of claim 5 allows for a tight seal formed by the seal face 24 and the socket, as may be seen in Fig. 4.

In contrast, the devices disclosed in the figures of the Publication do not appear to show a seal. Thus, the Publication does not anticipate claim 5 for at least this additional reason.

The Office Action alleges that the Publication discloses “an end face seal **(58)** that abuts against an end of the plug.” (Emphasis added.) Applicant respectfully submits that the Publication does not **appear to have an element 58**. None of the figures show a reference symbol labeled “58.” Applicant respectfully requests that, in any future action, the PTO specifically identify which figure of the Publication and the approximate location in the figure that portrays the reference number, else allow the claim.

**Claim 6:** In rejecting claim 6, the Office Action asserts that “**in paragraphs 17-48**, Japanese Publication No. 2000-16704 discloses a method for cleaning a socket,” comprising every element of claim 6. (Emphasis added.) Applicant respectfully submits that a proper foundation has not been laid by the PTO to reject claim 6 as anticipated based on the text of the Publication. No translation of the Publication has been provided, and the Office Action has made no mention that a translation is available.

Applicant respectfully submits that if the PTO intends to rely on a Japanese language publication as a basis for an anticipation rejection, the PTO must provide a translation of the Publication, else allow the claim. Moreover, the PTO must specifically point to the portions of the translation that anticipate the claim, as opposed to broadly alleging that the description of the preferred embodiments discloses the invention, followed by a quasi-reproduction of the claim that extends **over a page-and-a-half**.

Moreover, Applicant reminds the PTO that it is not enough that each element of claim 6 be scattered among paragraphs 17-48 of the Publication to anticipate claim 6; each element must be found in a single embodiment disclosed in the Publication. (See M.P.E.P. §

706.02(a) (“Once the examiner. . . finds a printed publication or patent which discloses the claimed invention, the examiner should determine whether the rejection should be made under 35 U.S.C. §§ 102(a), (b), or (e).” (emphasis added)).

**Claim 9:** Claim 9 recites a cleaning adaptor with two ends for attachment to a socket, the cleaning adapter including “locking collars for locking the socket that are fitted onto the both ends of the adapter main body.” An exemplary embodiment of the invention according to claim 9 may be seen in Figs. 5 and 6, where locking collars 62 lock the adapter to socket.

In contrast, the Publication fails to disclose an adapter with locking collars that are fitted onto both ends of an adapter main body. Claim 9 is simply not anticipated by any figure of claim 9.

Also, claim 9 recites that the locking collars are “for locking the socket.” (Emphasis added.) That is, the invention of claim 9 is configured to be securely fastened to a socket. In contrast, the Publication does not appear to disclose any locking mechanism for securing an adapter to a socket. Presumably, the Office Action is referring to the device of Fig. 7 in formulating the rejection of claim 9. Assuming *arguendo* that element 20 of Fig. 7 is an adapter, it appears that the case body of element 20 has an inner diameter that is about equal to the outside diameter of element 30 (assumed *arguendo* to be a socket). Therefore, the element 30 would only be held in element 20 by pressure insertion. Thus, any alleged adapter of the Publication does lock onto a socket.

### **Conclusion**

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a

check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

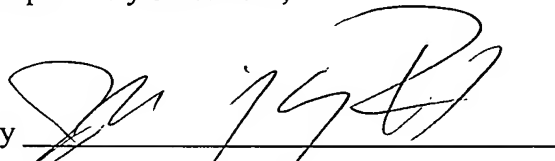
Examiner Dunwoody is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date

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By



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